UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,253	03/01/2002	Barbara A. Rincavage	RINCAVAGE-1	4031

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EXAMINER
BUI, KIM T

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/086,253	RINCAVAGE ET AL.
	Examiner	Art Unit
	Kim T. Bui	3626

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 March 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>3/1/02</u>

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claims 1-11,19, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A)   As per claim 1 "does not satisfy" 19 on line 19 is vague;

(B)   As per claims 10,11, 19, 20, "said sub-step" on line 2 lacks proper antecedent basis.

(C)   Dependent claims 2-11 incorporate the deficiency of the claim they depend on and are therefore rejected.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-9, 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denny (US2004/0107117) in view of Chung (US2003/006878).

(A)   As per claim 1, Denny discloses a prescription verification method comprising the steps of:

a.   providing a database. Denny, page 6, paragraph 0064.

b.   entering unfilled prescription prescribed by a physician to a patient into database

Denny, page 6, paragraph 0060.

c.   retrieving the prescription by a medical service professional (i.e.pharmacist)

selected by the patient to fill the prescription. Denny, page 3, paragraphs 0032,0036,.

d.   having the pharmacist fill the prescription for the patient. Denny, page 5,

paragraph 0055, page 7, paragraph 0065, Fig.7, step 220.

e.   entering data of the filled prescription. Denny, page 2, paragraph 0014, Fig. 7,

steps 244, 246.

f.   comparing prescription data received from the pharmacist to the data of unfilled

prescription stored in host system database. Denny, page 5, paragraph 0053.

g.   generating a signal (i.e. warning) if the data received from the pharmacist does

not correspond to the data of unfilled prescription stored in host system database.

Denny, page 5, paragraph 0053.

        Denny fails to expressly recite "filled prescription". It is, however, logical that the

prescription received from the pharmacist for comparison include filled information such

as dosage level, drug label as suggested by Denny on page 5, paragraph 0049. In

addition, it is well known to compare a filled prescription data with original prescription

data and to generate a warning as evidenced by Chung.

        On page 12, paragraph 0135, page 13,paragraph 0142, Fig. 8, Chung teaches

the comparison of information of medical dispensed/ medication smart tag, which is a

form of filled prescription, with the medication ordered/prescription smart tag, which is a

form of unfilled prescription.

It would have been obvious to one having ordinary skill in the art at the time of

the invention to include a comparison between filled prescription and unfilled

prescription information with the motivation of ensuring the completeness and accuracy

of the filling of prescription. Chung, page 13, paragraph 0142.

(B)   As per claim 12, Denny discloses a prescription verification method comprising

the steps of:

a.   inputting patient's prescription into a database. Denny, page 1, paragraph 0010,

page 6, paragraph 0060.

c.   retrieving the prescription by a medical service professional (i.e.pharmacist)

selected by the patient to fill the prescription. Denny, page 3, paragraphs 0032,0036,.

d.   having the pharmacist fill the prescription for the patient. Denny, page 3,

paragraph 0031, page 5, paragraph 0055, page 7, paragraph 0065, Fig.7, step 220.

e.   entering prescription information into database by pharmacist. Denny, page 2,

paragraph 0014.

e.   comparing prescription data received from the pharmacist to the data of unfilled

prescription stored in host system database. Denny, page 5, paragraph 0053.

f.   generating a signal (i.e. warning) if the data received from the pharmacist does

not correspond to the data of unfilled prescription stored in host system database.

Denny, page 5, paragraph 0053.

Denny fails to expressly recite "the volume". It is, however, logical that the

prescription received from the pharmacist for comparison include information such as

dosage level or volume as suggested by Denny on page 5, paragraph 0049. In addition,

it is well known to compare a volume data with original prescription data and to

generate a warning as evidenced by Chung.

On page 12, paragraphs 0132, 0135, page 13, paragraph 0142, Fig. 8, Chung

teaches the comparison of information of medical dispensed or volume of a filled

prescription, with the medication ordered/prescription smart tag (i.e. unfilled

prescription).

It would have been obvious to one having ordinary skill in the art at the time of

the invention to include a comparison between volume information provided by

pharmacist and unfilled prescription information with the motivation of ensuring the

completeness and accuracy of the filling of prescription. Chung, page 13, paragraph

0142.

On page 12, paragraph 0135, page 13, paragraph 0142, Fig. 8, Chung teaches

the comparison of information of medical dispensed/ medication smart tag, which is a

form of filled prescription, with the medication ordered/prescription smart tag, which is a

form of unfilled prescription.

It would have been obvious to one having ordinary skill in the art at the time of

the invention to include a comparison between filled prescription and unfilled

prescription information with the motivation of ensuring the completeness and accuracy

of the filling of prescription. Chung, page 13, paragraph 0142.

(C)   As per claims 2-5,13-16, Denny teaches the password protection (i.e,

authentication) or other security methods for ensuring that the healthcare provider (i.e.

physician) and the pharmacist are valid users. Denny, page 4, paragraph 0043. Denny.

As per the step for registering the authorized user, it is readily apparent that user

information for authorization must first be registered and stored at host system database

for later verification.

(D)   As per claim 9, Denny teaches the host system database accessed by

healthcare provider and pharmacist via a communication link. Denny, page 6,

paragraph 0064, Fig. 1.

(E)   As per claims 7, 8, 17, 18, Chung teaches the warning that prescription is not

filled to the specification or not filled properly on page 12, paragraph 0135.

(F)   As per claim 6, Denny teaches the prescription information includes drug label

(i.e. medication type, medication brand), dosage level (i.e. medication amount) and

applicable notes (i.e. cost) on page 5, paragraph 0049.

5.   Claims 10, 11, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Denny (US 2004/0107117) in view of Chung (US 2003/006878) and further in view

of the Official Notice.

(A)   As per claims 10, 11, 19, 20. Denny teaches the authentication by password or

other security methods on page 4 paragraph 0043, but fails to expressly recite biometric

verification. This is well known and the Examiner takes Official Notice on the biometric

verification.

It would have been obvious to one having ordinary skill in the art at the time of

the invention to include implement others security methods disclosed by Denny using

biometric verification technique with the motivation of conforming to standard practice.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "System for providing Pharmaceutical product information" US 2002/0065683).

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 571-272-6768. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KTB
2/16/06

C. LUKE GILLIGAN
PATENT EXAMINER